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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/745,493	12/22/2000	Nitin J. Shah	15685P070	1377

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EXAMINER	
DAO, MINH D	

ART UNIT	PAPER NUMBER
2682	8

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/745,493	SHAH, NITIN J.	
	Examiner	Art Unit	
	MINH D DAO	2682	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04/22/2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) _____ is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19 and 22* is/are rejected.

7)☒ Claim(s) *20,21* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Detailed Actions

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1. Claims 1-13, 17-19, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Claxton (US Patent 6,434,371) and further in view of Uchikura (US Patent 5,337,346).

Regarding claim 1, Claxton discloses an integrated mobile device (Col. 2, Lines 11-13) that provides local functionality and communication functionality (Col. 2, Lines 13-17), comprising: a power supply (Col. 7, Lines 3-7); a computing unit, coupled to the power supply (Col. 3, Lines 51-61; See Fig. 7, Item 102); a radio communication unit (Col. 4, Lines 4-19; See Fig. 6, Item 102); and a switch (Col. 4, Lines 35-40), coupled to power supply and to the computing unit (Col. 4, Lines 40-48), to selectively couple the radio communication unit to the power supply (Col. 4,Lines 35-49), such that the switch provides first and second modes of operation (Col. 4, Lines 35-49), wherein the first

mode of operation enables the computing unit and the radio communication unit (Col. 2, Lines 11-14). However, Claxton fails to teach that the second mode of operation disables the radio communication unit and enables the computing unit. Instead, Claxton only teaches that the second mode of operation disables the computing unit. In an analogous art, Uchikura teaches that the radio communication unit can be disabled and that the non-communication unit (e.g. the notebook unit) is enabled (Reference Uchikura, Col. 3, Lines 53-56). It would therefore have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Claxton and Uchikura so that one can avoid being disturbed or interrupted during a non-communication process. Since the non-communication unit of Claxton is a PDA which inherently comprises a computing unit. Therefore, the PDA unit reads on the computing unit as claimed.

Regarding claim 2, the combination of the teachings of Claxton and Uchikura teaches that the radio communication unit provides cellular communication between the mobile device and an external entity (Reference Claxton,Col. 2, Lines 11-17).

Regarding claim 3, the combination of the teachings of Claxton and Uchikura teaches that the computing unit comprises a data storage area to store information and a processor to retrieve the information (Reference Uchikura, Col. 5, Lines 15-30; See Fig. 4, items 27 and 31).

Regarding claim 4, the combination of the teachings of Claxton and Uchikura teaches that the information includes random access information (Reference Uchikura, Col. 5, Lines 15-30; See Fig. 4, item 31).

Regarding claim 5, the combination of the teachings of Claxton and Uchikura teaches that the wireless communication device of claim 3 wherein the information includes read-only information (Reference Uchikura, Col. 5, Lines 15-30; See Fig. 4, item 27).

Regarding claim 6, the combination of the teachings of Claxton and Uchikura teaches that the information includes multimedia information (Col. 5, Lines 51-66).

Regarding claim 7, the combination of the teachings of Claxton and Uchikura teaches that the wireless communication device of claim 1, wherein the computing device, when the radio communication unit is enabled, provides data communication functionality between the device and an external entity (Reference Uchikura, Col. 4, lines 51-59).

Regarding claim 8, it is inherent that the wireless communication device of Claxton communicates with a base station that includes an adaptive array because the wireless communication device of Claxton is a cellular telephone.

Regarding claim 9, the claim is the method claim of the apparatus of claim 1.

Therefore, the claim is interpreted and rejected for the same reason as set forth in claim 1.

Regarding claim 10, the combination of the teachings of Claxton and Uchikura fails to teach that the method of claim 9, further comprising providing a third mode of operation in which neither the wireless communication functionality nor the local functionality of the device is enabled. However, it is inherently known in the art that if the user does not wish to use the device he/she could simply switch off the device therefore all functionalities are disabled.

Regarding claim 11, the combination of the teachings of Claxton and Uchikura teaches that switching between the first and second modes of operation comprises: in the first mode of operation, providing power (Reference Claxton, Col. 4, Lines 60-67;Col.5, lines 1-2) to a computing unit and a radio communication unit of the integrated portable computing-communication device, wherein the computing unit provides the local functionality and the radio communication unit provides the communication functionality; and in the second mode of operation, providing power to the computing unit, and not providing power to the communication unit (Reference Uchikura, Col. 6, lines 50-58; See Figs. 1,3).

Regarding claim 12, the claim is interpreted and rejected for the same reason as set forth in claim 11.

Regarding claim 13, the combination of the teachings of Claxton and Uchikura teaches that the first mode of operation provides transfer of data between the portable device and an external entity (Reference Uchikura, Col. 4, lines 51-59).

Regarding claim 17, the claim has all limitations of claim 1 and therefore is interpreted and rejected for the same reason as set forth in claim 1.

Regarding claim 18, the combination of the teachings of Claxton and Uchikura teaches that the selection means comprises a switching means to switch between the first and second modes of operation (Reference Claxton, Col. 2, lines 7-17).

Regarding claim 19, the claim has all limitations of claim 12 and therefore is interpreted and rejected for the same reason as set forth in claim 12.

Regarding claim 22, the combination of the teachings of Claxton and Uchikura teaches that the device further comprising an indication means for indicating whether the apparatus is operating in the first or the second mode of operation (Reference Claxton, Fig.3, Item 310; Col. 4, Lines 64-67; Col. 5, Lines 1-5).

2. Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Claxton (US Patent 6,434,371), Uchikura (US Patent 5,337,346) and further in view of Ditzik US Patent 5,983,073.

Regarding claim 14, the combination of the teachings of Claxton and Uchikura fails to teach that the external entity includes a base station coupled to a data communication network. Ditzik in his invention teaches an external entity includes a base station coupled to a data communication network (Reference Ditzik, Col. 3, lines 16-21). It would therefore have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Claxton, Uchikura and Ditzik in order to be more efficient utilizing the provided bandwidth as data communication caries more information.

Regarding claim 15, the combination of the teachings of Claxton, Uchikura and Ditzik also teaches that the external entity includes a voice communication network (Reference Ditzik, Col. 11, lines 37-46; Fig. 7).

Regarding claim 16, the combination of the teachings of Claxton, Uchikura and Ditzik also teaches that the data communication network includes the Internet (Reference Ditzik, Col. 12, lines 58-62; See Fig. 7, item 54).

Allowable Subject Matter

3. Claims 20 and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claim 20, Claxton (US Patent 6,434,371) and Uchikura (US Patent 5,337,346) teach the limitations set forth in claim 17; however the combination of the teachings of Claxton and Uchikura fails to teach that the apparatus of claim 17, wherein an external entity triggers the selection means to select between the first and second modes of operation.

Regarding claim 21 with respect to claim 20 the combination of the teachings of Claxton and Uchikura did not teach that the apparatus of claim 20, wherein the external entity comprises a transmitter to transmit a signal that triggers the selection means to select between the first and second modes of operation.

Response to Arguments

4. Applicant's arguments filed 04/22/2004 have been fully considered but they are not persuasive.

Regarding claims 1, 9, and 17, the applicant argues that Claxton does not disclose a switch to selectively couple the radio communication unit to the power supply. However, examiner disagrees. Claxton discloses a switch that can be activated using the flip cover to determine the operating mode of the system (as stated in col. 4, lines 35-40; col. 2, lines 11-17). Therefore, one skilled in the art would recognize that the switch (controlled by the flip cover) of the communication device of Claxton would have to inherently couple the communication device to the power supply in order to bring power to the device so that one or both of the wireless telephone and the PDA can be activated in the corresponding SMARTPHONE and KEYPAD mode, respectively.

Still regarding claims 1, 9, and 17 the applicant argues that Uchikura only teaches one mode of operation. However, the examiner disagrees. Uchikura, once combined with Claxton provides two modes of operation wherein the first mode of operation enables the computing unit and the radio communication unit. In the second mode, the computing unit is enabled and the radio communication unit is disabled.

Therefore, the examiner believes that the rejection of claims 1-19 and 22 is proper. Claims 20 and 21 remained objected for the same reason stated in the previous office action.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MINH D DAO whose telephone number is 703-305-5589. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, VIVIAN C CHIN can be reached on 703-308-6739. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Minh Dao
Art Unit 2682
July 7, 2004

VIVIAN CHIN
SUPERVISORY PATENT EXAMINER
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